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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,973	05/20/2004	Heiko Rommelmann	A2132-US-NP	8632
25453	7590	12/13/2005	EXAMINER	
PATENT DOCUMENTATION CENTER XEROX CORPORATION 100 CLINTON AVE., SOUTH, XEROX SQUARE, 20TH FLOOR ROCHESTER, NY 14644			LA, ANH V	
			ART UNIT	PAPER NUMBER
			2636	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/849,973

Applicant(s)

ROMMELMANN ET AL

Examiner

Anh V. La

Art Unit

2636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/20/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. The specification is objected to because on page 1 and page 6, line 24, "XX/XXX,XXX" should be replaced by numbers.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10, 12, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Petteruti.

Regarding claim 1, Petteruti discloses a method of processing a module enclosed within a container, wherein the container includes an electronic tag 16a comprising a tag memory, the method comprising while the module is enclosed in the container, selectively storing 22 in the tag memory either first module information or second module information pertaining to the module (column 3, lines 20-50).

Regarding claim 2, Petteruti discloses selectively communicating over a wireless communication link either the first module information or the second module information to the tag (col. 3, lines 20-50).

Regarding claim 3, Petteruti discloses after storing either the first or second module information in the tag memory, electronically reading the stored information pertaining to the module from the tag memory, automatically performing a first action if

Art Unit: 2636

the tag memory contains the first information and automatically performing a second action if the tag memory contains the second information (col. 4, line 35-col. 5, line 25).

Regarding claim 4, Petteruti discloses installing the module in a printing apparatus 10, wherein performing the first action comprises performing the first action in the printing apparatus and wherein performing the second action comprises performing the second action in the printing apparatus (col. 3, lines 20-50).

Regarding claim 5, Petteruti discloses prior to selectively storing the first or second information in the tag memory, electronically reading tag identification information from the tag memory, determining if the read tag identification information matches predetermined identification criteria, storing the first or second module information in the tag memory only if the read tag identification information matches the predetermined identification criteria (col. 3, lines 20-50).

Regarding claim 6, Petteruti discloses transmitting an identification read request signal to the electronic tag and electronically receiving an identification response from the tag (col. 4, line 35- col. 5, line 25).

Regarding claim 7, Petteruti discloses a calculation (col. 4, line 35- col. 5, line 25).

Regarding claim 8, Petteruti discloses a method for processing a module comprising enclosing the module within a container, securely affixing to the container an electronic tag 16a comprising a tag memory, electronically reading tag identification information from the tag memory, electronically verifying that the read tag identification information matches predetermined identification criteria, and if the read tag

identification information matches the predetermined identification criteria, selectively storing in the tag memory either first module information or second module information, which module information pertains to a subsequent use of the module (col. 3, lines 20-50, col. 4, line 25- col. 5, line 25).

Regarding claim 9, Petteruti discloses an identification read request signal and an identification response (col. 4, line 35- col. 5, line 25).

Regarding claim 10, Petteruti discloses a wireless communication link (col. 3, lines 20-50).

Regarding claim 12, Petteruti discloses securing the tag to the container with adhesive (col. 3, lines 5-20).

Regarding claim 14, Petteruti discloses a container for enclosing a module comprising an enclosure, and an electronic tag 16a securely affixed to the enclosure (col. 3, lines 5-20), a tag memory, a tag identification segment, a tag identification respond, a tag communication element, a source 34, 22 to transmit tag identification responses generated by the tag identification segment, wherein the tag memory is adapted to store the information received by the tag communication element and wherein the tag memory is adapted to store at least first and second module information pertaining to the module to be enclosed in the container (col., 3, lines 20-50).

Regarding claim 15, Petteruti discloses calculating the tag identification response in response to a request received at the communication element (col. 4, lines 35- col. 5, line 25).

Regarding claim 16, Petteruti discloses the tag identification segment being a portion of the tag memory (col. 3, lines 20-50).

Regarding claim 18, Petteruti discloses the electronic tag being embedded in a label secured to the container enclosure (col. 3, lines 5-20).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti in view of Tuttle.

Regarding claims 11, 13, 17, and 19, Petteruti discloses all the claimed subject matter as set forth above in the rejection of claim 8, but does not disclose the container embedding the electronic tag (claims 11, 17) and securing the tag over a container opening separation (claims 13, 19). Tuttle teaches the use of a container 70 embedding an electronic tag 78 (col. 5, lines 25-30) and securing the tag over a container opening separation (figures 6A, 6b, 6). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the container embedding the electronic tag and securing the tag over a container opening separation to the method of Petteruti as taught by Tuttle for the purpose of protecting the container.

Art Unit: 2636

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rankin, Wiklof, and Barrett disclose RFID systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh V. La whose telephone number is (571) 272-2970. The examiner can normally be reached on Mon-Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANH V. LA
PRIMARY EXAMINER

Anh V La
Primary Examiner
Art Unit 2636

AI
December 01, 2005